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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,878	08/20/2003	Kevin T. Foley	03190.000013.1	5214
5514 7590 05/30/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
RAMANA, ANURADHA				
ART UNIT		PAPER NUMBER		
3733				
MAIL DATE		DELIVERY MODE		
05/30/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/643,878

Applicant(s)

FOLEY ET AL.

Examiner

Anu Ramana

Art Unit

3733

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11, 27 and 29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-11, 27 and 29 is/are rejected.
- 7) ☒ Claim(s) 5 and 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/20/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

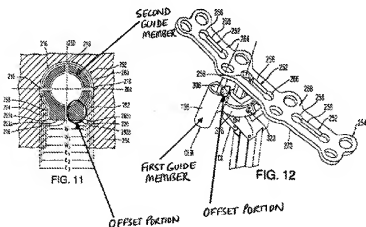
Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 7-8, 11 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brace et al. (US 6,342,057) in view of Oxland et al. (US 5,676,666).

Brace et al. disclose a drill guide assembly for use with a bone plate to correctly seat screws in the bone plate, the assembly including: a first guide member 136 and a second guide member 206 extending from a handle 126; each of the guide members having an offset portion adjacent a distal end of the guide member; each of the guide members having a main body portion of a first width, an intermediate portion having a second width less than the first width, and the slot engaging end having a third end less than the second width; and wherein the guide members are configured and dimensioned to fit bone plate fastener holes having an elliptical shape (Figs. 1-2, 6 and 10-12 and cols. 5, lines 19-67 and cols. 6-14). See marked up Figs. 11 and 12 from Brace et al. below.



Brace et al. disclose all elements of the claimed invention except for a bone plate having fastener holes with an elliptical shape.

Oxland et al. teach a bone plate having elliptically shaped holes disposed on opposing sides of a central axis for stabilizing cervical vertebrae (Fig. 2, col. 2, lines 64-67 and col. 3, lines 1-12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized the Brace et al. device to position fasteners through elliptically shaped holes of a plate, as taught by Oxland et al., since it was well known in the art to use a plate having elliptically shaped holes to stabilize cervical vertebrae.

Regarding claim 11, the combination of Brace et al. and Oxland et al. clearly disclose an offset. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided an offset of 1 mm or more, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Regarding claim 27, the guide members 136 and 206 are asymmetrical with respect to each other.

Claims 1-4, 7-11 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brace et al. (US 6,379,364 or '364 herein) in view of Brace et al. (US 6,342,057 or '057 herein) further in view of Oxland et al. (US 5,676,666).

'364 disclose a drill guide having first and second guide members (206, 208) wherein a distal end of each guide member is configured and dimensioned to fit bone plate fastener holes with arcuate shapes other than circular (col. 9, lines 66-67 and col. 10, lines 1-3).

'364 discloses all elements of the claimed invention except for a shape that enables the bushings to contact openings in a bone plate that are in the form of slots.

'057 teaches a shape for the distal end of a bushing such that the bushing engages slots in a bone plate (col. 7, lines 37-50).

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the known technique of providing a shape to the distal end of the bushings of '364, to enable the bushings to engage slots in a bone plate, as taught by '057, for the predictable result of removable engagement of the drill guide with slots in a bone plate.

The combination of '364 and '057 discloses all elements of the claimed invention except for a bone plate with slots positioned on opposing sides of a central axis.

Oxland et al. teach a bone plate having elliptically shaped holes disposed on opposing sides of a central axis for stabilizing cervical vertebrae (Fig. 2, col. 2, lines 64-67 and col. 3, lines 1-12).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized the device of the combination of '364 and '057 to position fasteners through elliptically shaped holes of a plate, as taught by Oxland et al., since it was well known in the art to use a plate having elliptically shaped holes, disposed on opposing sides of a central axis of the bone plate, to stabilize cervical vertebrae.

Regarding claim 11, the combination of '364, '057 and Oxland et al. clearly disclose an offset. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided an offset of 1 mm or more, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Response to Arguments

Applicant's arguments submitted under "REMARKS" in the response filed on February 29, 2008 have been fully considered.

Applicant's arguments with respect to the double patenting rejections have been considered and are persuasive. Accordingly, the Examiner is withdrawing the double patenting rejection.

Regarding the rejections of claims 1-4, 7-11 and 27 under 35 USC 103(a) over Brace et al. (US 6,342,057) in view of Oxland et al. (US 5,676,666), the Examiner reiterates that the limitation, "positionable in a corresponding one of said first and second slots against said first end of said corresponding slot" only requires the capability of the offset portion to contact the first end of the slot and is not a positive limitation and does not constitute a limitation in any patentable sense.

Contrary to Applicant's arguments, the Examiner notes that Brace et al. (US 6,342,057) clearly disclose drill tube 136 and bushing 206 to have offset portions (see marked up Figures provided in this action). It is also noted that a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987).

Allowable Subject Matter

Claims 5 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anu Ramana whose telephone number is (571) 272-4718. The examiner can normally be reached Monday through Friday between 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR
May 25, 2008

/Anu Ramana/
Primary Examiner, Art Unit 3733

